

# United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

CONFIRMATION NO. FIRST NAMED INVENTOR ATTORNEY DOCKET NO. FILING DATE APPLICATION NO. 5571 Joe Z. Tsicn 03/12/2002 10/009,228

7590

03/07/2006

LAW OFFICES OF ALBERT WAI-KIT CHAN, LLC

WORLD PLAZA, SUITE 604 141-07 20TH AVENUE WHITESTONE, NY 11357

**EXAMINER** STANDLEY, STEVEN H

PAPER NUMBER

ART UNIT 1649

DATE MAILED: 03/07/2006 -

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)	
Office Action Summary		10/009,228	TSIEN, JOE Z.	
		Examiner	Art Unit	
		Steven H. Standley	1649	
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply				
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).				
Status				
1)⊠	Responsive to communication(s) filed on <u>09 De</u>	ecember 2005.	`	
· · · · ·		action is non-final.		
3)	Since this application is in condition for allowan	ice except for formal matters, pro	secution as to the merits is	
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims				
4)⊠ Claim(s) <u>28-34</u> is/are pending in the application.				
	4a) Of the above claim(s) is/are withdrawn from consideration.			
5)	5) Claim(s) is/are allowed.			
6)⊠	6)⊠ Claim(s) <u>28-34</u> is/are rejected.			
7)	7) Claim(s) is/are objected to.			
8) Claim(s) are subject to restriction and/or election requirement.				
Application Papers				
9)☐ The specification is objected to by the Examiner.				
10) The drawing(s) filed on is/are: a) accepted or b) objected to by the Examiner.				
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).				
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).				
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.				
Priority under 35 U.S.C. § 119				
<ul> <li>12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).</li> <li>a) All b) Some * c) None of:</li> <li>1. Certified copies of the priority documents have been received.</li> <li>2. Certified copies of the priority documents have been received in Application No</li> <li>3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).</li> <li>* See the attached detailed Office action for a list of the certified copies not received.</li> </ul>				
2) Notice 3) Informer Pape	t(s)  e of References Cited (PTO-892)  e of Draftsperson's Patent Drawing Review (PTO-948)  mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  or No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:		

Art Unit: 1649

#### **DETAILED ACTION**

# Response to Amendment

The amendment filed 12/09/05 has been made of record. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action.

# Objections/Rejections: Withdrawn

# Claim Rejections - 35 USC § 112

The rejection of claims 29-34 under 35 USC 112, 2<sup>nd</sup> paragraph, for reciting a relative term is withdrawn due to Applicant's amendment.

# Objections/Rejections: Maintained/New Grounds

# Claim Objections

Objection to claims 29-34 is maintained for the reasons made of record in the office action dated 6/6/05. Applicant's arguments have been fully considered and not found to be persuasive. Applicant argues that the examiner agreed to examine claim 28. The examiner considered the claim only to the extent that it was readable upon the elected invention Group IV (claims 29-34).

This application contains a claim (28) drawn to an invention nonelected with traverse in Paper No. 3/09/05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Art Unit: 1649

### Claim Rejections - 35 USC § 112

Rejection of claim 28-34 under 35 USC § 112, 1st paragraph, enablement is maintained for the reasons made of record in the office action dated 6/06/05. Applicant's arguments have been fully considered and not found to be persuasive. Applicant argues only that the invention is fully enabled, stating that "the test compound enhanced learning and memory." It is noted by the examiner that Applicant argues that the nucleic acid overexpressing the NR2B subunit of the NMDA receptor in a transgenic animal is a "test compound." However, the claims use a cell expressing said nucleic acid as a "control" for comparison to evaluate the effects of another "test compound" on a cell that does not contain said nucleic acid. As argued in the office action of 6/06/05, the art discloses that a "test compound" affecting NMDA receptor expression, activity, or function does not enhance learning and memory (page 6-7 of office action), and that a test compound that does enhance learning and memory does not modify NMDA receptor expression, activity or function (see page 8 of office action). Therefore, given the complex nature of the invention, the contradictory prior art, the high level of unpredictability of the art, and the lack of guidance or examples as to how to make or use the invention as currently claimed, one skilled in the art would require undue experimentation to make and use the invention.

Application/Control Number: 10/009,228

Art Unit: 1649

#### Conclusion

Page 4

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H. Standley whose telephone number is (571) 272-3432. The examiner can normally be reached on 8:00-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Janet Andre can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Standley, Ph.D.

ROBERT C. HAYES, PH.D. PRIMARY EXAMINER